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ULTRA DIMENSION SDN BHD

v.

KETUA PENGARAH, LEMBAGA PENGGALAKAN PELANCONGAN MALAYSIA & ORS

B

HIGH COURT MALAYA, KUALA LUMPUR
AZAHAR MOHAMED J
[SUIT NO: D-21(IP)-125-2007]
5 MAY 2010

C

COPYRIGHT: *Affidavit - Contents - Whether true copy of work infringed must be annexed to affidavit - Whether failure to annex original photograph to affidavit rendered affidavit defective and invalid - Copyright Act 1987, s. 42(1)(a)*

D

COPYRIGHT: *Infringement - Establishing infringement - Ownership of copyright in photograph not established - Plaintiff no locus standi to sue for infringement - Copyright Act 1987, s. 37*

COPYRIGHT: *Infringement - Establishing infringement - Statutory* E *protection against copyright infringement claim - Photograph used by Malaysian Tourism Promotion Board in brochure published to public to promote tourism - No profit derived from publication and distribution of brochure - Whether Board accorded statutory protection under Copyright Act 1987 s. 13(2)(i)*

F

COPYRIGHT: *Infringement - Ownership of copyright - Whether ownership proven - Copyright in photograph - Whether ownership may be established without aid of Copyright Act 1987, s. 42 - Material discrepancy in evidence concerning who actually took photograph in* G *question - More than one party collaborating to create photograph - Ownership of copyright not established*

This copyright infringement action was brought by the plaintiff against the first defendant. The plaintiff claimed copyright of H photograph with images of the Kuala Lumpur Skyline with emphasis on sceneries and landmarks such as the KLCC and KL Towers. According to the plaintiff, the first defendant infringed its copyright photograph when the latter published the Visit Malaysia Year Brochure 2007 (the brochure) incorporating the photograph. The plaintiff therefore sought, *inter alia*, damages, delivery up, declaratory I relief, and inquiry as to damages or an account of profits against

the first defendant. The issue for determination was whether the plaintiff owned the copyright of the photograph. To establish ownership, the plaintiff relied on the affidavit affirmed by Bok Tak Siew (PW1) (the affidavit) made pursuant to s. 42 of the Copyright Act 1987 (the Act). However, the original photograph was not annexed to the affidavit. Learned counsel for the first defendant submitted that s. 13(2)(i) of the Act clothed the first defendant with statutory protection against the plaintiffs claim. The court therefore had to determine whether the Malaysian Tourism Promotion Board ("The Board") fell under the protection of s. 13(2)(i) of the Act.

Held (dismissing the plaintiff's claim with costs):

(1) Section 42 of the Act lays down a pre-condition for the admission of the affidavit, namely, a true copy of the work must be annexed to the affidavit. The requirement to annex the photograph to the affidavit is a condition precedent and mandatory; the court will require strict compliance. The failure to comply with the prerequisite of s. 42(1)(a) rendered the affidavit defective and invalid. Therefore, there was no *prima facie* evidence to show that the plaintiff was the copyright owner of the photograph. (paras 8 & 11)

(2) Section 42's affidavit is however not the only mode of proving ownership of copyright. As a statutory aid, it provides a means of proving ownership of the copyright in a work. (para 13)

(3) There was material discrepancy in PW1's evidence concerning who actually took the photograph in question. The first version was that PW1 personally took the photograph. On the other hand, the other version was that a group of photographers were involved in taking the photograph. It was not established that the photographers in the group were the employees of the plaintiff when the plaintiff took the photograph. Therefore the court was unable to make a finding that PW1 personally took the photograph. More than one party had collaborated to create the photograph and the contribution of each photographer was not distinct or separate from the other. As such, s. 26(2) of the Act did not in any way assist the plaintiff. (paras 15, 19, 23 & 24)

(4) Since the plaintiff failed to prove on the balance of probability that he was the owner of the copyright of the photograph, the plaintiff had no *locus standi* to sue for infringement as s. 37(1) of the Act provides that infringements of copyright shall be actionable at the suit of the owner of the copyright. (para 24)

(5) The board is a statutory body established by The Malaysian Tourism Promotion Act 1992 under the purview of the Minister of Tourism and therefore under the control of the Government of Malaysia. The brochure was published and distributed to the public to promote tourism. Thus, the photograph was used in the public interest to generate tourism revenue. The first defendant had distributed the brochure free of charge and derived no profit from the publication and distribution of the brochure. Therefore, the first defendant was accorded statutory protection under s. 13(2)(i) of the Act against the plaintiff's claim. (paras 27, 28 & 29)

Case(s) referred to:

Rock Records (M) Sdn Bhd v. Audio One Entertainment Sdn Bhd [2005] 1 CLJ 200 HC ***(refd)***

Microsoft Corporation v. Yong Wai Hong [2008] 6 CLJ 223 CA ***(refd)***

Najma Heptulla v. Orient Longman Ltd [1989] 1 FSR 598 ***(refd)***

Legislation referred to:

Copyright Act 1987, ss. 13(2)(i), 26(1), (2)(b), 36, 37(1), (5), 42(1)(a)(c)

Federal Constitution, arts. 39, 43

Malaysian Tourism Promotion Board Act 1992, ss. 8, 9

Rules of the High Court 1980, O. 18 r. 19(1)

Other source(s) referred to:

Khaw Lake Tee, *Copyright Law in Malaysia*, 2nd edn, pp 111, 119

Ida Madieha Abdul Ghani Azmi, *Copyright Law in Malaysia, Cases and Commentary*, p 122

For the plaintiff - SK Liow (Joyce Wong with him); M/s Liow & Co

For the 1st defendant - Manian Raju (Krishna with him); M/s Krishna Dallumah, Manian & Indran

Reported by Amutha Suppayah

JUDGMENT

Azahar Mohamed J:

[1] This is a copyright infringement action brought by Ultra Dimension Sdn Bhd (the plaintiff) against the Director-General of the Malaysian Tourism Promotion Board (the first defendant).

[2] The plaintiff claims copyright of photograph with the reference No. UD 3001 (the photograph). It is a photograph with images of the Kuala Lumpur Skyline with emphasis on sceneries and landmarks such as the KLCC and KL Towers.

[3] The plaintiff's case is that the first defendant infringed its copyright photograph when the latter published the Visit Malaysia Year Brochure 2007 (the brochure) incorporating the photograph.

[4] On such premises, the plaintiff seeks, *inter alia*, damages, delivery up, declaratory relief, and inquiry as to damages or an account of profits against the first defendant.

[5] At the outset, it must also be kept in mind that on 23 January 2009 this court struck out the writ of summons and the statement of claim against the Director-General of the Ministry of Tourism, Malaysia (the second defendant) and the Government of Malaysia (the third defendant) pursuant to O. 18 r. 19(1) of the Rules of the High Court 1980.

[6] Having said that, the critical issue for determination in this action is whether at all material and relevant times, the plaintiff is the owner of the copyright of the photograph. In this regard, the plaintiff avers in para. 6 of the statement of claim as follows:

> Pada kesemua masa yang material, Plaintif merupakan pemilik hakcipta yang sah bagi sebilangan gambar foto yang termasuk tetapi tidak terhad kepada gambar foto "UD 3001" yang dicetak di foto catalog Plaintif iaitu dikenali sebagai "Ultra Dimension Photo Catalog 3" (yang akan dikenali sebagai "Gambar foto tersebut"). Salinan Gambar foto tersebut akan dibentangkan di dalam perbicaraan kelak.

[7] Therefore, the pleaded case of the plaintiff is that they are the owner of the copyright of the photograph. To establish the same, the plaintiff relies on the affidavit affirmed by Mr Bok Tak

Siew (PW1) dated 24 April 2009 and marked as exh. P2 made pursuant to s. 42 of the Copyright Act 1987 (the Act). Section 42 of the Act provides:

> 42. Affidavit admissible in evidence.
>
> (1) An affidavit or statutory declaration made before any person having authority to administer oath by or on behalf of any person claiming to be:
>
> (a) The owner of the copyright in any works eligible for copyright under this Act stating that:
>
> (i) At the time specified therein copyright subsisted in such work;
>
> (ii) He or the person named therein is the owner of the copyright; and
>
> (iii) A copy of the work annexed thereto is the true copy thereof;
>
> shall be admissible in evidence in any proceedings under this Act and shall be *prima facie* evidence of the facts contained therein.

[8] As far as it is relevant to the present case, s. 42 lays down a pre-condition for the admission of the affidavit, namely, a true copy of the work must be annexed to the affidavit. Which is why in the very context of the present case, it is obligatory for the plaintiff to annex the photograph to the affidavit, P2. It cannot be emphasized enough that this requirement is a condition precedent and mandatory; the court will require strict compliance.

[9] Coming back to the present case, for ease of reference, I will quote the relevant portions of the affidavit that is relevant to the current discussion.

> Affidavit Pemilikan
>
> Saya, Bok Tai Siew (No. K/P: 681029-04-5015) seorang warganegara Malaysia yang cukup umur dan mempunyai alamat di No. 101, Persiaran 155A, Bukit OUG, Town House, 58200 Kuala Lumpur, dengan sesungguhnya berikrar dan menyatakan seperti berikut:
>
> 1. Saya adalah seorang Pengarah, pemegang saham dan Jurugambar bagi Plaintif yang dinamakan di atas, yang merupakan sebuah syarikat yang diperbadankan di Malaysia di bawah Akta Syarikat, 1965, dan saya telah diberikuasa dengan sempurnanya oleh Plaintif untuk membuat affidavit ini.

4. Saya menyatakan di sini bahawa Gambar Foto UD 3001 ("Gambar Foto tersebut") yang dicetak di foto catalog Plaintif iaitu dikenali sebagai "Ultra Dimension Photo Catalog 3" *inter alia* adalah diambil oleh saya sendiri bagi pihak Plaintif.

5. Saya menyatakan disini bahawa Gambar Foto tersebut telah diambil pada lebih kurang tahun 2000 dan diambil di sebuah pangsapuri di Bandar Baru Sentul.

6. Saya menyatakan di sini bahawa saya dan pasukan juru gambar Plaintif telah mencurahkan banyak usaha penat-lelah untuk menangkap Gambar Foto tersebut yang cantik dan bermakna. Bagi mendapatkan hasil yang terbaik, kami telah mencarikan suatu jarak dan cahaya yang sesuai, tempat yang sesuai dan sudut yang sesuai untuk menangkap gambar tersebut

7. Saya menyatakan di sini bahawa Gambar Foto tersebut adalah dimiliki oleh Plaintif, dan Plaintif adalah merupakan pemilik yang sah dalam undang-undang atas Gambar Foto tersebut yang mana dilindungi di bawah Akta Hak Cipta, 1987.

8. Gambar Foto tersebut adalah dilindungi di bawah Akta Hak Cipta, 1987 kerana:

   i. Gambar Foto tersebut adalah pada asalnya diambil dan dihasilkan oleh Plaintif melalui Jurugambar saya sendiri dengan menggunakan camera yang berjenama "Sinar Large Format" dari negara Swiss.

   ii. Gambar foto merupakan sesuatu "karya artistic" yang layak dilindungi di bawah Seksyen 7(1) Akta Hak Cipta, 1987;

   iii. Gambar Foto tersebut telah dihasilkan dengan banyak usaha penat-lelah bagi mengambil atau menghasilkan gambar yang asal; dan

   iv. Gambar Foto tersebut telah direkodkan, atau dijadikan dalam bentuk material dimana telah dicetak dalam "Ultra Dimension Photo Catalog 3".

9. Maka, saya menyatakan di sini bahawa Plaintif adalah pemilik yang sah kepada Gambar Foto tersebut dan sebagai pemilik yang sah, juga mempunyai hak penguasaan dan perlindungan dari segi undang-undang dalam perkara pelanggaran Hak Cipta Gambar Foto tersebut di bawah peruntukan Akta HakCipta 1987.

A 11. Sesalinan Gambar Foto tersebut adalah dieksibitkan bersama affidavit saya ini dan ditandakan sebagai "Exhibit A"; dan adalah dirujuk sebagai sesalinan asal Gambar Foto tersebut.

[10] One matter immediately comes to light from the evidence presented by the plaintiff. With regard to the above para. 11 of P2, B it cannot be disputed that in fact "exh. A" was not annexed to the affidavit. Learned counsel for the plaintiff argued that this was due to an administrative oversight. He argued that it should not affect the admissibility of P2.

C **[11]** This argument is untenable for the reason that the plaintiff by its own evidence clearly shows that P2 does not fully fulfil the statutory requirement of s. 42, which I have mentioned earlier. In my judgment, the failure to fully comply with the prerequisite of sub-para. (1)(a) of s. 42 renders the affidavit to be defective and D invalid. For that reason, no reliance can be placed on the statutory provision.

[12] What then is the effect? The effect is that there is no *prima facie* evidence to show that the plaintiff is the copyright owner of the E photograph.

[13] Now, it is true that s. 42's affidavit is not the only mode of proving ownership of copyright. As a statutory aid, it provides a means of proving ownership of the copyright in a work (see: *Rock Records (M) Sdn Bhd v. Audio One Entertainment Sdn Bhd* [2005] F 1 CLJ 200 and *Microsoft Corporation v. Yong Wai Hong* [2008] 6 CLJ 223).

[14] With that, the question arises whether besides P2 the evidence of PW1 has, on the balance of probability, proved that the G plaintiff is the copyright owner in law of the photograph at all material times.

[15] In this regard, the evidence of PW1 is far from satisfactory. Upon perusal of the evidence of PW1, I am of the view that there H is material discrepancy in his evidence concerning who actually took the photograph in question.

[16] As stated earlier in P2, at para. 2 this is exactly what PW1 affirmed under oath, "Saya menyatakan di sini bahawa Gambar Foto I UD 3001 ("Gambar Foto tersebut") yang dicetak di foto catalog plaintif iaitu dikenali sebagai "Ultra Dimension Photo Catalog 3" *inter alia* adalah diambil oleh saya sendiri bagi pihak plaintif".

[17] This is in sharp contrast to para. 8.1 where PW1 affirmed that "Gambar Foto tersebut adalah pada asalnya diambil dan dihasilkan oleh plaintif melalui Jurugambar saya sendiri dengan menggunakan kamera yang berjenama "Sinar Large Format" dari negara Swiss". A

[18] Then, this is what PW1 said in examination-in-chief (see: exhibit P1-witness statement): B

> S. Sila rujuk kepada gambar foto kod nombor UD3001 di muka surat 1 dalam Ikatan Dokumen-dokumen Plaintif (Bahagian B). Siapakah yang menangkap gambar foto tersebut? C
>
> J. Saya mengetuai satu pasukan Jurugambar untuk menangkap gambar foto tersebut.

Nevertheless, he further said: D

> S. Sila terangkan berkenaan proses yang diambil untuk menangkap gambar tersebut?
>
> J. Saya telah mencurahkan banyak usaha penat-lelah untuk menangkap gambar foto tersebut yang cantik dan bermakna. E

Further down, he added:

> S. Apakah perasaan anda terhadap pelanggaran hakcipta oleh Defendan terhadap gambar foto tersebut?
>
> J. Saya berasa amat kecewa sekali kerana hakcipta Plaintif telah dicerobohi dan tidak dihormati langsung. Saya dan juru gambar yang lain juga merasakan keghairahan untuk mengambil gambar telah pupus dan hilang akibat kekerapan pelanggaran hak cipta gambar ini. Kami tidak merasakan sebarang ganjaran apabila mencurahkan banyak usaha untuk mengambil sesuatu gambar foto. F G

[19] A scrutiny of the evidence of PW1 will reveal that there is a serious and material contradiction who actually took the photograph. The contradictions are obvious. The first version is that PW1 personally took the photograph. On the other hand, the other version is that a group of photographer was involved in taking the photograph. H

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[20] This brings me to this important principle: Under copyright law, there is a distinction between authorship and ownership. The author refers to the creator or originator of the work while the owner is the person who is entitled to control the doing of the various restricted acts (see *Copyright Law in Malaysia* by Khaw Lake Tee, 2nd edn, at p. 111).

[21] In general, a person who creates the work is the author of the work. In relation to this, s. 26(1) of the Act provides that copyright shall vest initially in the author. Then, s. 26(2)(b) of the Act provides, *inter alia*, where a work is made in the course of the author's employment, the copyright in such work shall be deemed to have transferred to the author's employer, subject to any agreement excluding or limiting such transfer. What I gather from the provision is that the copyright in the work is deemed to be transferred to the employer once it comes into existence, without any formalities or any written assignments. The effect of s. 26(2) is that a work created by an employee in the course of employment will accrue to the employer (see: *Copyright Law in Malaysia, Cases and Commentary* by Ida Madieha bt Abdul Ghani Azmi, at p. 122). By reason thereof, it is therefore important to determine whether such work is created in the course of employment or not.

[22] Two points should now be made. The first is that in the present case, it has not been established that the photographers in the group were the employees of the plaintiff. More importantly, it has not been proved that the photographers were in the course of employment when the plaintiff took the photograph.

[23] The second point is that in light of the unexplained discrepancy, I am unable to make a finding that PW1 personally took the photograph. In fact, further difficulties arise because more than one party had collaborated to create the photograph, and it seems to me based on the evidence of PW1, each of the photographers had made contributions of the skill and labour protected by the copyright (see: *Najma Heptulla v. Orient Longman Ltd* [1989] 1 FSR 598). Moreover, it appears that the contribution of each photographer is not distinct or separate from the other in the creation of the photograph (see: *Copyright Law in Malaysia* by Khaw Lake Tee, 2nd edn, at p. 119).

[24] In this way, s. 26(2) of the Act does not in any way assist the plaintiff. That being the case, following the evidence as presented by the plaintiff, it is my judgment that the plaintiff has failed to prove on the balance of probability that it is the owner of the copyright of the photograph. The plaintiff case fails on the evidence. That is why, in my view, the plaintiff has no *locus standi* to sue for infringement as s. 37(1) of the Act provides that infringements of copyright shall be actionable at the suit of the owner of the copyright. Furthermore, s. 37(5) of the Act reads that owner of the copyright means the first owner or an assignee, as the case may be, of the relevant part of the copyright.

[25] Next, I move on to deal with the submission of learned counsel for the first defendant to the effect that s. 13(2)(i) of the Act clothes the first defendant with statutory protection against the plaintiffs claim. Generally, a copyright owner is entitled to all the statutory rights conferred by ss. 13 and 36 of the Act. This includes, among other things, the right to control the reproduction, the distribution of copies to the public by sale and the commercial rental to the public.

However, s. 13(2)(i) also provides:

> Notwithstanding subsection (1), the right of control under that subsection does not include the right to control:
>
> i) Any use made of a work by or under the direction or control of the Government, by the National Archives or any State Archives, by the National Library, or any State library, or by such public libraries and educational, scientific or professional institutions as the Minister may by order prescribe, where such use is in the public interest and is compatible with fair practice and the provisions of any regulations, and:
>
> (i) no profit is derived there from; and
>
> (ii) no admission fee is charged for the performance, showing or playing if any, to the public of the work thus used;

[26] Based on this provision, an interesting question becomes apparent: whether the Malaysian Tourism Promotion Board (hereinafter known as the board) falls under the protection of s. 13(2)(i) the Act.

[27] First of all, it cannot be disputed that the board is a statutory body duly established by The Malaysian Tourism Promotion Board Act 1992 (the 1992 Act). Indeed, in the statement of claim, the plaintiff averred that, "defendan pertama merupakan sebuah lembaga statutory dan/atau agensi kerajaan ..." As stipulated by the 1992 Act, the functions of the board include to stimulate and promote tourism to and within Malaysia; to stimulate, promote and market, internationally and locally, Malaysia as a tourist destination; to coordinate any marketing or promotion activity in relation to tourism conducted by any government department or governmental or non-governmental agencies or organizations; and to make recommendations to the Minister as to the methods, measures and programmes to be adopted to facilitate and stimulate the development and promotion of the tourism industry in Malaysia and where approved by the Minister, to implement or assist in the implementation of the methods, measures and programmes in question. Of greater relevance is s. 8 of the 1992 Act, which provides that the board shall be responsible to the Minister, and the Minister may from time to time give directions not inconsistent with the provisions of this Act and the board shall give effect to all such directions. Under the 1992 Act, Minister means the Minister for the time being charged with the responsibility for tourism. Then, s. 9 provides that the board shall furnish to the Minister such information with respect to its property and activities as the Minister may from time to time require or direct. The Minister is a member of the cabinet (see: arts. 39 and 43 of the Federal Constitution). By virtue of all these provisions and the articles in the Federal Constitution, I am of the view that the board is under the purview of the Minister of Tourism and therefore it is under the control of the Government of Malaysia.

In this very context, it is relevant to note that the brochure in question carried a message of the Minister of Tourism, Malaysia. This is exactly what the Minister said:

> It gives me great pleasure to pen a few words in this VMY2007 Domestic Holiday Packages booklet.
>
> This attractive booklet which contains new domestic travel packages is most timely in view of the coming Visit Malaysia Year 2007.
>
> I am convinced that the many interesting and affordable packages featured in this booklet will interest and encourage many people to take holiday and travel in Malaysia.

> Besides allowing the tour operators a chance to develop and show case innovative and comparative travel packages, this booklet offers Malaysians with a wide choice of hassle-free vacations.
>
> As we prepare for Visit Malaysia Year 2007, I would like to thank all those who have contributed to this effort, particularly the private sector such as MATTA, BUMITRA, Malaysian Airlines, AirAsia, Keretapi Tanah Melayu Berhad and Maybank for coming forward to support our campaign to promote Malaysia.

[28] From this, I understand the brochure, which incorporated the photograph in question, was published and distributed to the public with a view to promote tourism in our country. By reason of doing so, I am of the view that the photograph in question was used in the public interest to generate tourism revenue for our country. In essence, the expression 'public interest' means the well-being or the general welfare of the public. Moreover, it is an undisputed fact that the first defendant had distributed the brochure free of charge. PW1 himself testified that he obtained copies of the brochure free. This also indicates that the first defendant derived no profit from the publication and distribution of the brochure.

[29] It is in the light of all these, to my mind, the first defendant is accorded statutory protection under s. 13(2)(i) of the Act against the plaintiffs claim.

[30] For all these very reasons, I see no alternative but to dismiss the whole of the plaintiff's claim with costs.